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FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			LIANG, GWEN	
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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/547,397

Applicant(s)

SATOMI ET AL.

Examiner

GWEN LIANG

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-44 and 47-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-44 and 47-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08112005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to communications through the applicant's amendment, filed on 6/15/2005 and Request for Continued Examination (RCE) filed on 7/14/2005.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 43, 47-49, 50-53 and 54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claim 43, the claimed subject matter, an apparatus, does not contain a computer component to be recognized as a computer related invention, and therefore it cannot produce a concrete, useful, and tangible result. The claimed invention is not supported by either an asserted utility or a well established utility, containing the claimed "acquisition unit", "search unit" and "output unit".

Claim 43 is also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either an "acquisition unit", a "search unit" and an "output unit" asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Regarding independent claim 50, the claimed subject matter, a method, is nonstatutory because a method lacks assured results unless the method is tangibly embodied on a computer-readable medium. The language of the claim raises a

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question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

The claimed method consists solely of the manipulation of an abstract idea. A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459. The claim is devoid of any limitation to a practical application in the technological arts, and hence non-statutory.

For such subject matter to be statutory, the claimed method must be limited to a practical application of the abstract idea in the technological arts. A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See *AT &T*, 172 F.3d at 1358, 50 USPQ2d at 1452.

The examiner suggests that the claimed "method" be amended to read, " method tangibly embodied on a computer-readable medium".

Regarding independent claim 54, the claimed subject matter, a system, is not tangibly embodied in a computer-readable medium, nor does it contain a computer component to be recognized as a computer related invention, and therefore it cannot produce a concrete, useful, and tangible result. The claimed invention is not supported

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by either an asserted utility or a well established utility, containing the claimed "storing unit".

Claim 54 is also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a "storing unit" asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 43, 47-49, and 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In independent claim 43, the claimed subject matters, "acquisition unit", "search unit" and "output unit" are not supported in the specification.

In independent claim 54, the claimed subject matters, "a first storing unit" and "a second storing unit" are not supported in the specification.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 39-44, 47-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowman et al., "Bowman" (U.S. Patent No. 6,006,225).

With respect to claim 39, Bowman discloses a method ... comprising:

a first storing step, of storing a first information associated with an identification associated with an identification code in a database (Abstract and col. 2, line 47 – col. 3, line 5);

a second storing step of storing a second information associated with a keyword in a second database (col. 5, lines 26-28,, "The query server 132 includes a related term selection process 139 which identifies related query terms based on query term correlation data stored in a correlation table");

a first search step, of searching said first database for first information corresponding to an inputted identification code, wherein the first information has a keyword (col. 14, lines 13-31 and Figure 9, wherein "OUTDOOR TRAIL" is equivalent to an inputted identification code and the retrieved result set of "OUTDOOR TRAIL-BIKE",

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"OUTDOOR TRAIL-SPORTS" and "OUTDOOR TRAIL-VACATION" is equivalent to the first information, wherein the first information has a key word, (for example BIKE));

a second search step, of searching said second database for second information based on the keyword of the first information searched by said first search step (col. 14, lines 13-31, particularly, lines 26-28, "...the query server 132 automatically selects the related term at the top of related terms list (such as the term "bike" in the FIG. 9 example), and searches the query result to identify a subset of query result items that include this related term", wherein searching for second information is based on the keyword "bike"); and

an output step, of outputting the first information searched by said first step and the second information searched by said second search step together as being visible information (Figure 9, wherein the display includes both the first information and the second information).

Claim 40 is rejected for the reasons set forth hereinabove for claim 39 and furthermore Bowman discloses a method wherein the first information has a weight value, and said second search step is executed based on the keyword of the searched information and in consideration of the weight value of the keyword (col. 12, lines 42-67).

Claim 41 is rejected for the reasons set forth hereinabove for claim 39 and furthermore Bowman discloses a method wherein said second search step is executed when an output layout of content of the searched first information is determined (See for

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example: Fig. 9, wherein the determination of an output layout of the searched first information is inherent in order for this information to be displayed).

Claim 42 is rejected for the reasons set forth hereinabove for claim 39 and furthermore Bowman discloses a method wherein said second search step is executed based on the keyword of the searched first information and in consideration of at least property information of a user who inputs the identification code or device property information of an output device, which is used to output content of the searched first information and content of the searched second information together (col. 12, lines 2-12).

Claim 43 is rejected on grounds corresponding to the reasons given above for claim 39 and furthermore Bowman discloses an apparatus comprising an acquisition unit adapted to acquire an identification code (col. 14, lines 13-15, 'FIG. 9 illustrates a sample query result page 900 in which a user has performed a subject field search on the terms "OUTDOOR TRAIL"', wherein the term "OUTDOOR TRAIL" is equivalent to an identification code);

Claims 47-49 are rejected on grounds corresponding to the reasons given above for claims 40-42.

Claim 44 is rejected on grounds corresponding to the reasons given above for claim 43.



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Claims 50-53 are rejected on grounds corresponding to the reasons given above for claims 43, 47-49.

Claim 54 is rejected on grounds corresponding to the reasons given above for claim 39.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 39-44, 47-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto et al., "Morimoto" (European Patent No. 343918).

With respect to claim 39, Morimoto discloses a method ... comprising:

a first storing step, of storing a first information associated with an identification associated with an identification code in a database, (Figure 3a, Data "b", wherein the "X" is an identification code used to identify the phone number of company X );

a second storing step of storing a second information associated with a keyword in a database (col. 4, lines 9-12, "The data-storing unit 14 is a data base that stores the data input by means of the input unit 11. The unit 14 stores such data on the basis of keywords");

a first search step, of searching said first database for first information corresponding to an inputted identification code, wherein the first information has a

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keyword (col. 5, lines 7-45, "... First, the keyword "A" is input ... Next, the data retrieval-controlling unit 15 retrieves the datum "a" of FIGURE 3a having the keyword "A" which has been stored in the keyword memory ... Thereafter, keywords associated with the datum "a" are extracted by the keyword-extracting unit ...");

a second search step, of searching said database for second information based on the keyword of the first information searched by said first search step (col. 5, lines 42-50, "... The operations of Step 4 through Step 7 are continuously performed until all the data having the keyword "X" are extracted (Step 8). After the continuous retrieval of the keyword "X" in Step 8, the datum "b" of FIGURE 3a can be extracted"; col. 6, lines 1-3, 'Next, the apparatus retrieves data on the basis of the keyword "X", and obtains the datum "b"; col. 6, lines 20-25, "... the retrieval operations of relational data are performed twice. Specifically, the second retrieval is performed on the basis of the keyword "X" included in the datum "a" which has been extracted by the first retrieval"); and

an output step, of outputting the first information searched by said first step and the second information searched by said second search step together as being visible information (col. 6, lines 9-12, "After the completion of the prescribed data retrieval, the display unit 12 displays the data "a" and "b" to which flags are added as the result of retrieval").

Morimoto does not explicitly teach the use of "a second database" to store information. However, it is obvious to modify Morimoto reference to use a second database to store a second information, since the first information and the second

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information are structurally similar, both containing identification information and corresponding data. To store them both in one database or any number of databases is just a design choice as taught in Morimoto that obviously, numerous additional modifications and variations of the present invention are possible in light of the above teachings (col. 7, lines 12-14).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a second database to store a second information as taught by Morimoto. For example: Data "a" and Data "b" in Figure 3a may very well be stored in two separate database. To store them both in one database or in any number of databases is just a design choice as taught in Morimoto that obviously, numerous additional modifications and variations of the present invention are possible in light of the above teachings (col. 7, lines 12-14) One of ordinary skill in the art would be motivated to make the aforementioned combination with reasonable expectation of success.

Claim 43 is rejected on grounds corresponding to the reasons given above for claim 39 and furthermore Morimoto discloses an apparatus comprising an acquisition unit adapted to acquire an identification code (col. 4, lines 6-9, "The input unit 11 inputs data and keywords associated therewith. Further, the unit 11 inputs commands for designating keywords of data to be retrieved, and for executing such retrieval", wherein "keywords" are equivalent to identification codes);

Claims 44, 50 are rejected on grounds corresponding to the reasons given above for claim 43.

Claim 54 is rejected on grounds corresponding to the reasons given above for claim 39.

### **Response to Arguments**

9. Applicant's amendments in response to the rejection of claims 43 and 50 under 35 U.S.C. 101 in the previous office action have been fully considered but the amendment does not overcome the 101 rejection based on reasons stated above in this office action.

10. Applicant's arguments regarding all pending claims that Bowman does not make a second search as set out in the claims and that in particular, Bowman does not perform searching such as a search on the keyword "bike" in the search result of the "outdoor trail-bike", have been fully considered but they are not persuasive. As reasons stated for claim 39 in this office action, Bowman teaches the first search step, as is acknowledged by the applicant (on page 9, paragraph 2 of the applicant's remarks). In the example taught in Bowman, col. 14, lines 13-31 and Figure 9, "OUTDOOR TRAIL" is equivalent to an inputted identification code and the retrieved result set of "OUTDOOR TRAIL-BIKE", "OUTDOOR TRAIL-SPORTS" and "OUTDOOR TRAIL-VACATION" is equivalent to the first information, wherein the first information has a key word, (for example BIKE)). A second step of search based on the keyword "bike" is taught in two different embodiments. The first embodiment is a manual step disclosed in col. 14, lines 18-22, "If the user clicks on the hyperlink "OUTDOOR TRAIL--BIKE," the

search engine will perform a search using the terms "S-OUTDOOR," "S-TRAIL," and "S-BIKE," and will then return the associated items. The second embodiment is an automatic step disclosed in col. 14-31, lines 24-31, "Any of a variety of additional techniques can be used in combination with this hyperlink-based interface. For example, in one embodiment, the query server 132 automatically selects the related term at the top of related terms list (such as the term **"bike"** in the FIG. 9 example), and **searches the query result** to identify a subset of query result items that include this related term". Therefore the Examiner maintains that the Bowman does teach a second search as set out in the claims as claimed in the applicant's invention.

11. Furthermore, new grounds of rejection have been applied in view of additional prior art being located.


**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GWEN LIANG whose telephone number is 571-272-4038. The examiner can normally be reached on 12:00 P.M. - 8:30 P.M. Monday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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15 August 2005  
G.L.

  
Primary Examiner